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| PUBLICATION NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
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| EXAMINER |
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| ART UNIT | PAPER NUMBER |
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THE PROCTER AND GAMBLE COMPANY  
6000 CENTER HILL AVE.  
CINCINNATI OH 45224

DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

Responsive to communication(s) filed on 8/8/97

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

Extended statutory period for response to this action is set to expire 3 month(s), or thirty days, never is longer, from the mailing date of this communication. Failure to respond within the period for response will cause application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1(a).

#### Disposition of Claims

Claim(s) 1-27 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
Claim(s) \_\_\_\_\_ is/are allowed.  
Claim(s) 1-27 is/are rejected.  
Claim(s) \_\_\_\_\_ is/are objected to.  
Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

☒ Notice of Reference Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 4, 5

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

## DETAILED ACTION

### *Specification*

1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.
2. The disclosure is objected to because of the following informalities: The summary is incomplete as it makes no mention of the lotion being applied nonuniformly. Appropriate correction is required.

### *Claim Rejections - 35 U.S.C. § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dreier et al. (5,171,236) in view of Buchalter (3,896,807) further in view of Duncan (3,489,148).

Dreier discloses a disposable diaper including a topsheet, a backsheet and an absorbent core wherein the topsheet is made from a hydrophilic material. (7:60-8:10)

Buchalter discloses an oil phase empregnant in the form of a non-oily solid that forms a cream upon the application of perspiration and heat (3:10-12) that is used on

articles such as facial mask, slippers, sanitary napkins, diapers and diaper liners wherein the therapeutic cream is applied to the skin. (3:14-20) The wear's skin will produce sufficient moisture and heat to cause emulsification of a portion of the oil phase. The substance is dry non-oil non-greasy solid at room temperature (6:13-16) and it is essentially free from water. (6:51-53)

The formulation is made from about 1% to about 99% and preferably from about 30% to about 70% of an oily material which includes mineral oil and petrolatum (3:30-40), and from about 99% to about 1% and preferably from about 30% to about 70% of an immobilizing agent. The resulting preparation can be applied to the article in a liquid phase and cooled to form a solid oil phase (6:38-40).

The oil phase may additionally include, but are not limited to paraffin, vegetable oils, animals oils and isopropyl palmitate (3:35-41). The oil phase is in the form of a dry, nonoily, nonsticky solid at room temperature, and comprises an oily material and one or more emulsifying agents and may include in addition, one or more emollients etc. (2:32-50) It is important that water is not present in the oil phase before emulsification (6:51-53).

The immobilizing agent or emulsifying agent includes cetyl alcohol, long chain fatty acid partial esters of a hexitol anhydride wherein the fatty acid has at least 6, preferably from 12 to 18, carbon atoms including the long chain fatty acid partial esters of sorbitan, sorbide, mannitan and mannide and mixtures thereof (3:42-55),

polyoxylalkyne derivatives and soaps of aliphatic acids (4:9-50) The emulsifying agent appears to be an equivalent to applicants' immobilizing agent.

Duncan discloses a diaper including a topsheet with a discontinuous coating of oleaginous substance beneficial to the skin in a localized area of the topsheet.

Dreier discloses an absorbent product including a hydrophilic topsheet.

Buchalter teaches that it is known to apply a skin care product to sanitary napkins and diapers that will emulsify a portion of the oil phase upon moisture and heat and Duncan teaches applying a lotion nonuniformly to a central portion of a topsheet. It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply a lotion as taught by Buchalter, to a diaper as taught by Dreier in a nonuniform manner since Buchalter's substance is not greasy and oily and Duncan teaches that a continuous coating is not needed, which will save money.

With respect to claims 1, 11, 12, 29-31, 13-16 and 34-39, it would have been obvious to one of ordinary skill in the art at the time the invention was made to coat Buell's diaper with Buchalter's lotion to prevent chafing or chapping of the skin.

It would have been obvious to one having ordinary skill in the art at the time the invention was made as a matter of design choice to apply the lotion in stripes wherein the immobilizing agent comprises a polyhydroxy fatty acid ester or a polyhydroxy fatty acid amide having the specific formulas as in claims 24 or 25 or an agent such as paraffin wax, since applicant has not disclosed that the particulars unexpectedly solves

any stated problem or is for any particular purpose and it appears that the invention would perform equally well as disclosed by Buchalter and Duncan and Dreier.

I must conclude that the use apply the lotion in stripes wherein the immobilizing agent comprises a polyhydroxy fatty acid ester or a polyhydroxy fatty acid amide having the specific formulas as in claims 24 or 25 and an immobilizing agent such as paraffin wax are merely a matter of engineering design choice, and thus do not serve to patentably distinguish the claimed invention over the prior art. See In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

Applicant is also reminded that arguments toward the criticality of an element will generally be given little patentable weight. The basis for criticality should be disclosed in the specification or supplied by affidavit. See In re Cole, 140 USPQ 230 (CCPA 1964).

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 5,607,760; 5,609,587; 5,643,588 and 5,635,191 in view of Duncan (3,489,148).

### ***Claim Rejections - 35 U.S.C. § 112***

7. Claims 14 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 27, it is not clear if applicant is claiming the wearer and whether applicant is claiming the article or the method of use of the article.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. WO 94/09757 cited by applicant discloses a cream and a lotion that can be applied to a diaper

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark O. Polutta whose telephone number is (703) 308-2114.

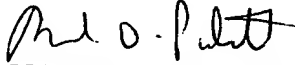
The examiner's supervisor, John Weiss, telephone number is (703) 308-2702. The fax phone number for official papers for this Group is (703) 305-3590.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0858.

Mark O. Polutta  
November 22, 1998

  
**MARK O. POLUTTA**  
**PRIMARY EXAMINER**  
**SECTOR 3700**